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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,482	11/01/2001	Charles W. Moorman	CWMM-25,915	1383

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CHAUZA & HANDLEY, L.L.P.  
PO BOX 140036  
IRVING, TX 75014

EXAMINER

HAYES, BRET C

ART UNIT PAPER NUMBER

3644

DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/001,482

Applicant(s)

MOORMAN, CHARLES W.

Examiner

Bret C Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 May 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 1 – 11 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 1 recites the limitation "the hand" in line 2. There is insufficient antecedent basis for this limitation in the claim. Further, line 9, "as" should be --a--.
4. Re – claims 2 – 11, any claim dependent upon a rejected base claim is also rejected.
5. Further, claim 7 recites the limitation "the forearm" in line 5. There is insufficient antecedent basis for this limitation in the claim.
6. Claim 13 recites the limitation "the hand" in line 3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 – 7 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Galbraith.

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9. Regarding claim 1, Galbraith discloses a portable arm support for supporting an object **12** held in a hand of a user **10**, comprising a saddle **13**, fastening straps **14**, a support tube **15** having first and second ends, the first end being pivotally mounted to the saddle **13**, col. 2, lines 9 – 13, a pocket member **19** having a cavity **21** for receiving the second end **18** of the support tube **15**, and a portion of the saddle **13** defines a steady rest. To reiterate from the previous Office Action, Paper no. 7, pp 33, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed **does not differentiate** the claimed apparatus from a prior art apparatus **satisfying the claimed structural limitations**. *Ex parte Masham*, 2 USPQ2d 1647 (1987). (*Emphasis added.*) In other words, claiming that the structure “defines a steady rest which directly engages against the object,” constitutes intended use and therefore does not differentiate.

10. Regarding claim 2, Galbraith further discloses a retaining member **30**.

11. Regarding claims 3 and 11, Galbraith further discloses the support tube **15** being telescopically extensible, col. 2, lines 9 – 11, and including an attachment member **23**.

12. Regarding claim 4, Galbraith further discloses at least one latch means **23**.

13. Regarding claim 5, Galbraith further discloses the pocket member **19** being secured to a waist belt of the user, the cavity facing upward, and including a belt fastener strap, i.e., Fig. 1.

14. Regarding claim 6, Galbraith further discloses the saddle **13** having a first saddle member **26** and a smaller second saddle member **27** rigidly attached to each other and member **27** having a swivel aperture, see Figs. 2 and 3, and swivel pin **30**.

15. Regarding claim 7, Galbraith further discloses fastening straps **14** secured to the opposite end of the saddle **13** to secure the arm of a user. While Galbraith does not disclose securing to a

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forearm of a user, as indicated above regarding claim 1, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). In this case, Galbraith discloses the claimed structural limitations, which, to secure to an upper arm or a forearm, constitutes intended use.

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galbraith, as applied to claims 1 – 7 and 11 above, in view of US Patent No. 5,410,835 to Vetter.

18. Regarding claims 8 and 14, Galbraith discloses the claimed invention except for disclosing a metal retaining clip.

19. Vetter teaches a retaining clip 26 in the same field of endeavor for the purpose of holding struts 12, 20 together when not needing to be separated.

20. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Galbraith to include such clip in order to keep the saddle 13 and tube 15 releasably securable to each other.

21. Claims 9, 10, 12, 13, 15 – 17, 19 and 20 are rejected under 35 U.S.C. § 103 as being unpatentable over Galbraith.

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22. Regarding claims 9 and 15, Galbraith discloses the claimed invention except for the specific shapes of the first and second saddles. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the first and second saddles to any desired shape, since there is no invention in merely changing the shape or form of an article without changing its function except in a design patent. *Eskimo Pie Corp. v. Levous et al.*, 3 USPQ 23.

23. Regarding claims 10, 16, 19 and 20, Galbraith discloses the claimed invention, including a swivel pin, as set forth at col. 2, lines 50 – 54, “pivotally connected to the upper end of the inner tubular member 16, as at 30, for rotative adjustment of the arcuate member 13 about a horizontal axis...”, except for the L-shape of the swivel pin. It would have been an obvious matter of design choice to use a swivel pin, since Applicant has not disclosed that the swivel pin solves any stated problem or is for any particular purpose and it appears that the invention performs equally well with the pivotal connection as disclosed by Galbraith and the equivalence of this to a swivel pin is well known in the art.

24. Regarding claims 12 and 13, Galbraith discloses the claimed invention, including a belt pocket 19 defining an upwardly facing cavity 21 and having a belt fastener strap 31 mounted to one side of the pocket 19, except for the saddle members being formed of leather. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use leather or any other desired material known in the art, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

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25. Claims 17 and 18 are rejected under 35 U.S.C. § 103 as being unpatentable over Galbraith in view of US Patent Nos. 5,775,021 to Weiss or in view of 3,632,087 to Phillips.

26. Regarding claims 17, 18 and 20, in view of pp 24 above concerning claim 16, Galbraith discloses the claimed invention, including inner **16** and outer **17** tube sections telescopically engaged to each other, except for an attachment member comprising flexible line which is attached to opposite ends of the inner **16** and outer **17** tube sections, such that the inner **16** tube section cannot be fully removed from within the outer **17** tube section.

27. Weiss teaches an attachment member **16** comprising flexible line which is attached to opposite ends of collapsible tubing sections **14** and can be tensioned, such that the sections **14** cannot be fully removed from within each other, col. 4, lines 57 – 65, in the firearm art for the purpose of collapsibly connecting cleaning rod segments.

28. Phillips teaches an attachment member **84** comprising flexible line, set forth at col. 3, line 72, which is attached to opposite ends of two telescopically engageable tubular members **54**, **56**, such that the inner **54** tube section cannot be fully removed from the outer **56** tube section in the telescopically engageable tubular member art for the purpose of limiting the amount of extension available telescopically between two members to a point where the two members cannot be separated from one another.

29. It would have been obvious to modify Galbraith to include a flexible line attached to opposite ends of inner and outer tube sections, such that the inner section cannot be fully removed from the outer section as taught by either Weiss or Phillips in order to connect two or more telescopically engageable members together.

***Response to Arguments***

30. Applicant's arguments filed 28 May 2003 have been fully considered but they are not persuasive.

31. Regarding the arguments traversing the rejection of claims 1 – 7 and 11, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

32. Applicant's arguments with respect to claims 12 and 13 have been considered but are moot in view of the new ground(s) of rejection.

33. Regarding the arguments traversing the rejection of claims 8 and 14, Galbraith does disclose the saddle having first and, smaller, second saddle members **26, 27**, an aperture, seen in Figs. 2 and 3, in the second member **27** and the support tube **15** being rotatably supported in the aperture by a swivel pin **30**. Further, in response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one of ordinary skill in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ 545 (CCPA



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1969). In this case, securing one member to another member via a metal retaining clip would be obvious.

34. Regarding the arguments traversing the rejection of claims 9, 10, 15 – 17, 19 and 20, as stated in pp 22 above, the changing the shape or form of an article without changing its function is no invention. In this case, the saddle members **16** and **18** perform the same function as do members **26** and **27**, and, so, constitute no invention.

35. Further in response to the arguments traversing the rejection of claims 9 and 15, in response to the Applicant's arguments, 37 CFR § 1.111(cb) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." The argued 'structural interrelationships' are disclosed, or obviated, and, further, the examiner has never stated their being 'merely ornamental'. Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the references.

36. Further, Applicant's arguments with respect to claims 10, 16, 19 and 20, have been considered but are moot in view of the new ground(s) of rejection.

37. Further, regarding the arguments traversing the rejection of claims 17, 19 and 20, see pp 33 and 35 above.

### ***Conclusion***

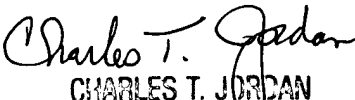
Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (703) 306-0553. The examiner can normally be reached Monday through Friday from 6:00 am to 6:30 pm, Eastern Standard Time.

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If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Jordan, can be reached at (703) 306-4159. The fax number for this group is (703) 305-7687.

bh

7/6/03

  
CHARLES T. JORDAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600